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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,794	02/23/2004	Mark Roland Boeder	CHRE:178	6789

7590 08/25/2005

PARKHURST & WENDEL
SUITE 210
1421 PRINCE STREET
ALEXANDRIA, VA 22314

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,794

Applicant(s)

BOEDER, MARK ROLAND

Examiner

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as being anticipated by the Plant Breeder's Right publication QZ PBR 011850.

The publication was published 2/15/02, more than a year prior to the filing date of the instant application.

Applicant has admitted that the plant was first placed on sale in The Netherlands on August 2002. Applicant further clarifies that flowering stems including flowers and foliage, were usually sold at auction. The sale of the plant was not a single solitary occurrence and one of ordinary skill in the art would have been able to obtain the plant. Plant auctions in The Netherlands are closely followed by those of ordinary skill in the art. Evidence of the economic importance is cited under "Applications" of the "EconPort" web site http://www.econport.org:8080/econport/request?page=man-auctions_dutchauuction (copy attached). Almost ¾ of The Netherlands total export of horticultural products in 2002 consisted of flowers and plants sold at Dutch flower auctions.

Knowledge of how to asexually propagate asters is commonly known to one of ordinary skill in the art as evidenced by page 614 of the RHS reference that states that propagation of chrysanthemums is invariably "from softwood basal growths (page 614, column 1, second full paragraph). The next two paragraphs expand on propagation techniques. As a result, this rejection meets the criteria set out by *In re Elsner* that the sale not be an isolated occurrence and that one of ordinary skill would have known how to propagate the instant plant.

Chrysanthemum may also be propagated from tissue culture (Karim et al., 2002). As a result, it would have been within the capability of one of ordinary skill in the art to propagate chrysanthemum even if only cut flowers and foliage was available. The references section lists several publications detailing the tissue culture of chrysanthemum. Examples are Ben-Jaacov et al., Battacharya et al., Hoque et al., and others. Clearly, one of ordinary skill in the art would have been able to reproduce the instant plant more than one year prior to the filing date regardless of what type of tissue was available, e.g. whole plants, or cut flowers and foliage.

However, this case is different from *Elsner* in the sense that a name change has occurred: 'Two tone Pink' as opposed to 'Cetwotone Pink' or a breeder's reference number. This, in no way, has limited the ability of one of ordinary skill to obtain the plant. One of ordinary skill could have contacted the breeder at the address listed on the publication or as listed on the internet or other avenue (see for example a list of contact telephone numbers and addresses at <http://www.cba-nv.nl/index.cfm?act=Agenten.default>. The address for the plant breeders right is stated

Art Unit: 1661

as "Chrysanthemum Breeders Association N.V., Abraham Mendes Chumaceiro Boulevard 11, Willemstad-Curacao, AN" alternatively, "Postbus 370, 1430 AJ Aalsmeer, The Netherlands." So one of ordinary skill in the art would have been able to obtain the plant even if they were not present at the auction. These facts are not contested by Appellant nor has Appellant explained why one of ordinary skill in the art would not have been able to obtain the plant by contacting the breeder. Once the breeder was contacted, the breeder would have informed the purchaser under what name the plant was currently being sold and where to buy it, or they would have sold it themselves.

Plants are commonly marketed using a different name than that found in a patent. Trade names are commonly given to plants once they are sold, or as in the instant case, plants are sometimes marketed as a group and given a group name. Just because the name is changed does not affect the fact that the plant was publicly available. One of ordinary skill in the art still would have been able to obtain the plant and reproduce it as well. A person of ordinary skill in the art at the time the invention was made would have known to contact the breeder, whose contact information is listed on the Plant Breeder's Right application, and ascertain that the plant was being sold under a particular name as well as from where to buy or otherwise obtain the plant. It is deemed that a name change does not in any way limit the plant from being obtained and reproduced and as such, the rejection under 35 U.S.C. 102(b) would still apply. The second requirement made in *In re Elsner* that one of ordinary skill in the art must be able to reproduce the invention. Propagation of chrysanthemum is well known in the art as discussed previously.

Art Unit: 1661

Applicants argue that the denomination is not the same. This argument has been previously addressed.

Applicants also argue that the CPVO does not release information pertaining to parentage.

This argument has been carefully considered but is not persuasive because the plant was already in the public arena. It was not necessary to recreate the plant "from scratch" nor would it have been possible to do so given a basic understanding of genetics. However, this is not the issue because the plant was already sold, albeit under a different name.

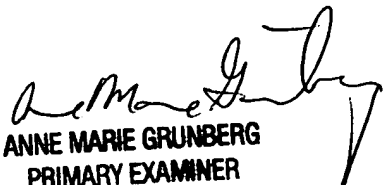
If all Applicant need do, is change the name of the plant, then conceivably any plant from overseas could be sold here under a different name and not infringe any intellectual property rights. It is clear that a difference in names does not obscure the fact that one of ordinary skill in the art could have bought the plant as the sale was not a single, isolated occurrence, and reproduced the plant as asexual reproduction of chrysanthemum is well documented in the art, thus enabling the Plant Breeder's Right publication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grunberg whose telephone number is 571-272-0975. The examiner can normally be reached on Monday - Friday 8:00-4:30.

Art Unit: 1661

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANNE MARIE GRUNBERG
PRIMARY EXAMINER